

Serial No. 10/722,863

Docket No. NG(ST)6508

REMARKS

Claims 1-40 are currently pending in the subject application, and are presently under consideration. Claims 1-15 are allowed. Claims 16-18, 20-24, 26-29 and 31-39 are rejected. Claims 19, 25, 30 and 40 have been indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 16, 17, 19-22, 28, 34, 35, 38 and 40 have been amended herein and claim 33 has been cancelled.

Favorable reconsideration of the application is requested in view of the amendments and comments herein.

I. Rejection of Claims 16, 18, 20-24, 26-29 and 31-39 Under 35 U.S.C. §102

Claims 16, 18, 20-24, 26-29 and 31-39 stand rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 5,640,679 to Lundqvist, et al. ("Lundqvist"). Withdrawal of this rejection is respectfully requested for at least the following reasons:

Regarding claim 16, this claim has been amended to incorporate selected subject matter set forth in combinations of claims 22 and 23. The Office Action contends that Lundqvist discloses the system of claim 22 and cites generally to Col. 5, line 42, through Col. 6, line 63, and FIGS. 3 and 5 of Lundqvist to support rejections for claims seemingly relevant to amended claim 16. In particular, the Office Action alleges that the ability of a base station master controller (MSC) to control the base stations and to transmit handoff commands corresponds to what is being recited in claims 22 and 23. In contrast to this assertion, however, Lundqvist fails to teach or even suggest that the MSC provides a contingency plan to each of the base stations that might inform a given mobile unit of at least one selected secondary BTS to communicate with in the event the mobile unit loses contact with the primary BTS. In fact, the language in the Office Action in which the MSC can "continuously control" base stations demonstrates the absence of a contingency plan being provided. Additionally, the contingency plan

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recited in amended claim 16 specifically informs a given mobile unit of one or more selected secondary BTS to communicate with in the event the mobile unit loses contact with the primary BTS. In sharp contrast, the approach in Lundqvist teaches no such information provided by the MSC, but instead, as stated in the Office Action, provides for continual control and "transmits handoff commands to base stations for assigning the mobile terminals." See Office Action at page 4. That is, Lundqvist provides for no plan that informs a mobile unit of what to do in the event contact is lost with its primary BTS, but instead would implement handover by the continuous control and commands that can be provided (none of which includes a plan as recited in amended claim 16). For these reasons, amended claim 16 is not anticipated by Lundqvist and its allowance is respectfully requested. Reconsideration and allowance of dependent claims 17, 22-24, 26 and 28 are also respectfully requested for at least these reasons and for the specific elements recited in such claims.

Additionally, claims 18, 20, 21 and 27 have been amended to depend from claim 19, which has been indicated as being allowable. Claim 19 has been amended into independent form, including the subject matter of original claim 16. Accordingly, claim 19 and claims 18, 20, 21 and 27 depending therefrom are allowable and their allowance is respectfully requested.

Claim 22 has been amended to be consistent with the amendment to claim 16. Additionally, regarding claim 22, similar to as discussed above with respect to claim 16, Lundqvist fails to disclose the contingency plan that is provided by the controller in claim 22. That is, the continual control and transmission of handoff commands mentioned in the Office Action are not disclosed as any plan and further fail to represent instruction that enable handover to a secondary BTS that is identified in the contingency plan.

Claim 28 has been amended to correct a typographical error. Regarding claim 28, the Office Action contends that the subject matter is taught by Lundqvist for the same reasons as discussed with respect to claims 21 and 23. However, claim 28 recites structural and functional interrelationships (in a means plus function format) not

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recited in claims 21 and 23, such that grounds for rejection of claim 28 fail to present a prima facie case of unpatentability. Additionally, claim 28 should be patentable for the reasons discussed above with respect to amended claim 16, since Lundqvist fails to teach a controller (as in claim 28) that includes means for providing a plan to a mobile unit, which plan includes a contingent carrier for the mobile unit to switch to in the event of a carrier loss. Moreover, both the rejection and Lundqvist are deficient as to any teaching of means for assigning a contingent BTS to the mobile unit for communicating with the mobile unit on the contingent carrier that is part of the plan provided to the mobile unit. The absence of the use of a plan, as recited in claim 28, becomes evident when considered in view of the purpose of the teachings of Lundqvist; namely to determine and compensate for time shift when implementing handover - not a new approach for implementing handover as in the present application. Reconsideration and allowance of claim 28 are respectfully requested. Claims 29, 31 and 32 are patentable for at least the same reasons as claim 28 and for the specific features recited in such dependent claims.

Claims 34, 35 and 38 have been amended to depend from claim 40, which the Office Action has indicated as being allowable. Claim 40 has been amended into independent form, including the subject matter of original claim 33. Accordingly, claim 40 and claims 34, 35, 36, 37, 38 and 39 depending therefrom are allowable, and their allowance is respectfully requested. Additionally, claim 38 is patentable for substantially the same reasons discussed above with respect to claim 28.

For the reasons described above, claims 16, 18, 20-24, 26-29 and 31-39 are patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

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II. Rejection of Claim 17 Under 35 U.S.C. §103(a)

Claim 17 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Lundqvist in view of U.S. Publication No. 2001/0024430 to Sekine, et al. ("Sekine"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claim 17 has been amended to correct a typographical error. Sekine fails to make up for the deficiencies of Lundqvist discussed above with respect to claim 16, such that claim 17 is also allowable. For the reasons described above, claim 17 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

III. Allowable subject matter

Applicant notes with appreciation the allowance of claims 1-15. Claims 19, 25, 30 and 40 have also been indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As suggested in the Office Action, Applicant has amended claims 19 and 40 to independent form including all of the limitations of the base claim and any intervening claims, as suggested in the Office Action. Other claims indicated as containing allowable subject matter are also allowable as they depend from allowable claims as discussed above. Allowance of claims 19 and 40 and claims depending therefrom is respectfully requested.

IV. CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the present application is in condition for allowance. Applicant respectfully requests reconsideration of this application and that the application be passed to issue.

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If the Examiner has any questions or if the Applicant or its representative can be of any assistance in connection with prosecution of this application, the Examiner is invited and encouraged to contact the undersigned at the number identified below.

Submitted herewith is a check for payment of three additional independent claims. No other fees should be due for this amendment and response; however, please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,



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